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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,576	11/03/2000	Brian L. Schmidt	279.268US1	6166
21186	7590	10/05/2005		
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402			EXAMINER DOLINAR, ANDREW M	
			ART UNIT	PAPER NUMBER
			3747	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/706,576

Applicant(s)

SCHMIDT ET AL.

Examiner

Andrew M. Dolinar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-9, 42-44, 49-53 and 55-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 42-44, 49-53 and 55-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/13/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Declaration Under 37 CFR 1.131***

The declaration filed on July 13, 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Miltich et al reference.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Miltich et al reference.

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it. *In re Tanczyn*, 347 F.2d 830, 146 USPQ 298 (CCPA 1965). Applicant's declaration does not establish possession of all of the claimed subject matter, for example, aluminum construction (e.g. claim 1) and medical device features (e.g. claim 42).

Applicant may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date. However, as discussed above, applicant's 37 CFR 1.131 affidavit must show possession of either the whole invention as claimed or something falling within the claim(s) prior to the effective date of the reference being antedated; it is not enough merely to show possession of what the reference happens to show if the reference does not teach the basic inventive concept. See MPEP § 715.02.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7-9, 42-44, 49-53, 55-59, 61, 64, 66-70 and 72-76 are rejected under 35 U.S.C. 102(e) as being anticipated by Miltich et al (US 6,402,793 B1). The implantable medical device of Miltich et al includes a capacitor with a conductor welded between case 90 and lid 110 as disclosed at column 31, lines 3-59, and shown in FIGS 27 and 28. The capacitor is constructed with a stack of flat metal layers as disclosed at column 13, lines 21-33.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-9, 49, 50-52, 55, 57, 58, 66-68, 69, 72-74 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macpherson (US 1,474,486) in view of Rayno (US 3,389,311). Macpherson discloses the claimed invention except for aluminum construction. As shown in Fig. 1, the capacitor has a conductor 5 between case B and lid MC. Rayno

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teaches that it is known to construct capacitor components of aluminum. See column 2, lines 31-57, and column 3, lines 13-29. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the capacitor of Macpherson out of aluminum, as taught by Rayno. The selection of a known material based on its suitability for its intended use has been held to be obvious. See *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Claims 60, 62, 63, 65, 71 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miltich et al (US 6,402,793 B1) in view of Rorvick et al (US 6,009,348). Miltich et al discloses the claimed invention as stated above except for the anode connection to the case. Rorvick et al teaches that it is known to connect either a cathode or an anode to a capacitor case. See claims 52 and 53. It would have been obvious to one having ordinary skill in the art at the time the invention was made to connect the anode to the case of the capacitor of Miltich et al rather than the cathode, as taught by Rorvick et al, because Rorvick et al provides a suggestion that the structures are equivalent and it has been held that reversal of parts is an obvious expedient. *In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955).

Claims 6 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miltich et al (US 6,402,793 B1) in view of Kemkers et al (US 3,938,228). Miltich et al discloses the claimed invention as stated above except for the end-on connection of a terminal wire to the capacitor case. Kemkers et al teaches that it is known to connect a terminal wire end-on to a capacitor case. See column 2, lines 30-34, and Fig. 2. It would have been obvious to one having ordinary skill in the art at the time the invention was made to connect a terminal wire

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end-on, as taught by Kemkers et al, to the case of the capacitor as shown in FIGS 27 and 28 of Miltich et al in order provide for attachment of a plug connector.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive. The declaration under 37 CFR 1.131 is ineffective to overcome the Miltich et al reference for the reason set forth above.

Applicant's arguments with respect to claims 1, 3-5, 9, 49, 50, 55, 66, 68, 69, 72, 74 and 75 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew M. Dolinar whose telephone number is (571) 272-4840. The examiner can normally be reached on Mon. - Thu. 7:45 - 6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Yuen can be reached on (571) 272-4856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Andrew M. Dolinar  
Primary Examiner  
Art Unit 3747

AMD